DETAILED ACTION

1. Claims 79, 80, 88, 89, 98, and 102 have been canceled. Claims 73-79, 81-87, 90-97, 99-101, and 103-110 are pending.

2. This Office Action is in response to amendments filed 11/19/2007 and 2/8/2008.

3. Below, Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date

under 35 U.S.C. 120 as follows: the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/011129, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The parent application provides no support for the limitations of "electronic circuitry carried on or in the substrate, wherein the electronic circuitry comprises information stored therein" or "wherein the code once obtained unlocks the electronic circuitry or the information stored therein" or "visible light scan data associated with text characters". Therefore, the preceding limitations are at the least, not given benefit of the, 11/18/1999, filing date. See Response to Arguments.

Drawings

1. The objected to the drawings under 37 CFR 1.83(a) is withdrawn in view of drawing sheet filed 11/19/2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. **Claims 73-77, 79-84, 86-88, 90-93, 95, 97-105, and 107-110** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij (US 5,790,662)**, herein after "Valerij" in view of **Rhoads (US 6,285,776)**, hereafter "Rhoads".

Considering **Claim 73,** Valerij discloses an identification document (column 1- lines 18-20) comprising: a substrate (Fig. 1- item 1); a first graphic carried on or in the substrate (column 1- lines 18-20, it is inherent that a driver's license would include a first graphic), the first graphic representing a photographic image or artwork (column 1- lines 18-20); and electronic circuitry carried on or in the substrate (Fig. 1- item 2, column 2- lines 5-6), wherein the electronic circuitry comprises information stored therein (column 2- lines 10-14), wherein the first message comprises at least a code (Fig. 1- item 4 and item 5, column 4- lines 57-59, column 5- lines 6-17) and wherein the code once obtained unlocks the electronic circuitry or the information stored therein (column 5- lines 37-51 and 66-67, column 6- lines 1-11 and 26-29).

Valerij does not explicitly disclose the first graphic comprises, steganographically encoding therein through alterations to data representing first graphic, the encoding including a plural-bit first message that is machine-readable from optical scan data corresponding to at least a portion of said first graphic.

Rhoads discloses the first graphic comprises, steganographically encoding therein through alterations to data representing first graphic, the encoding including a plural-bit first message that is machine-readable from optical scan data corresponding to at least a portion of said first graphic (column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Valerij to steganographically encode therein through alterations to data representing first graphic, the encoding including a plural-bit first message that is machine-readable from optical scan data corresponding to at least a portion of said first graphic as taught by Rhoads to provide a particularly high degree of protection against imitation when the covering layer is printed in the area of the markings such that the markings are unrecognizable to a human viewer (Valerij- column 7- lines 64-67).

Considering **Claim 77, 86, 94, 101, 104** the combination of Valerij and Rhoads discloses an identification document (Valerij- column 1- lines 18-20) comprising a

substrate (Valerij- Fig. 1- item 1); a photographic representation of an authorized bearer of the identification document carried on or in the substrate (Valerij- column 1- lines 18-20); machine-readable symbols printed with ink or dye on or in the substrate (Rhoads- column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38); and electronic circuitry carried on or in the substrate (Valerij- Fig. 1- item 2, column 2- lines 5-6), wherein the electronic circuitry comprises information stored therein (Valerij- column 2- lines 10-14), the machine-readable symbols representing data that is machine readable from visible light scan information corresponding to at least a portion of the machine readable symbols (Rhoads- column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38), and wherein the data once obtained unlocks the electronic circuitry or the information stored therein (Valerij- column 5- lines 37-51 and 66-67, column 6- lines 1-11 and 26-29).

Considering **Claim 107,** the combination of Valerij and Rhoads discloses a method comprising: obtaining visible scan data associated with text characters printed on an identification document to obtain first data (Valerij- column 1- lines 18-20, Rhoads- column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38): and using at least a portion of the first data to facilitate decryption of information- not the text characters- carried on or by the document (Valerij- column 5- lines 66-67, column 6- lines 1-11 and 26-29), wherein the information corresponds to the identification document or to an authorized bearer of the identification document (Rhoads- column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38).

Considering **Claims 74, 83, and 92,** the combination of Valerij and Rhoads discloses the substrate comprises multiple layers (Valerij- column 2- lines 1-2, column 3- lines 1-4).

Considering **Claims 75, 82, and 91,** the combination of Valerij and Rhoads discloses the identification document comprises at least one of a driver's license, passport, and photo-identification card (Valerij- column 1- lines 18-24).

Considering **Claims 76, 84, 93, and 108,** the combination of Valerij and Rhoads discloses the information carried on or in the substrate is utilized as at least one of an encryption key or a decryption key (Valerij- column 5- lines 66-67, column 6- lines 1-11 and 26-29).

Considering **Claim 81, 90, 100, and 110,** the combination of Valerij and Rhoads discloses the machine-readable symbols are steganographically encoded in the photographic-representation of the authorized user (Rhoads- column 3- lines 48-67, column 4- lines 1-8, column 18- lines 34-38).

Considering **Claim 95,** the combination of Valerij and Rhoads discloses at least a portion of the information - once processed - is for cooperation with the electronic

circuitry or the data stored therein (Valerij- column 5- lines 37-51 and 66-67, column 6- lines 1-11 and 26-29).

Considering **Claims 105 and 109,** the combination of Valerij and Rhoads discloses the information is carried on or in the substrate with digital watermarking (Rhoads- abstract).

Considering **Claims 80, 87, 97, 99, and 103,** the combination of Valerij and Rhoads does not explicitly disclose the identification document comprises a passport. Valerij does suggest that the data carrier is suitable for electronic identity media such as driving licenses, health insurance certificates..." (Valerij- column 1- lines 18-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the data carrier as taught by Valerij as a passport in order to provide a data carrier and an associated write/read device with improved security against forgery, imitation or fraudulent use of the data carrier (Valerij- column 1- lines 40-44)

2. **Claim 85** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij and Rhoads** in view of **Wang (US 5,337,361)**, hereafter "Wang".

Considering **Claim 85,** the combination does not explicitly disclose the symbols represent human readable information. Valerij does suggest that the symbols represent data indicative of an expiration date for the data carrier, which would be human-readable information (Valerij- column 5- lines 14-15).

Wang discloses the symbols represent human readable information (column 9- lines 28-37, Fig. 7)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Valerij and Rhoads by the symbols representing human readable information as taught by Wang in order to detect counterfeiting. For example, for those records which use photographs for identification, the information on the record could include further identifying information about the owner of the record, such as eye color, hair color, height, weight, etc. Then, if a new photograph were inserted over the appropriate photograph, the information would not match the new photograph and the counterfeiting would be detected (Wang- column 1- lines 48-57).

3. **Claim 96** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij and Rhoads** in view of **Kristol et al. (US 5,799,092)**, herein after "Kristol."

Considering **Claim 96,** the combination does not explicitly disclose at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein.

Kristol discloses at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein (column 4- lines 57-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Valerij and Rhoads using the hash function in cooperation with the data stored in the electronic circuitry as taught by Kristol for the benefit of encoding the image signature (Kristol- abstract, lines 10-12) using a well-known hash function (Kristol- column 4- lines 60-61).

4. **Claim 106** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij and Rhoads** in view of **Behram et al. (US 5,499,293)**, herein after "Behram."

Considering **Claim 106,** the combination does not explicitly disclose the information is obtained from the optical scan data through optical character recognition.

Behram discloses the information is obtained from the optical scan data through optical character recognition (col. 8- lines 38-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Valerij and Rhoads by obtaining information through optical character recognition as taught by Behram for the benefit of using an inexpensive "ink on paper" approach to create the cards (Behram- column 8- lines 38-42).

Response to Arguments

1. Applicant's arguments with respect to **Claims 73-106** have been considered but are moot in view of the new ground(s) of rejection.

2. Regarding the priority claim by the applicant. It is the determination of the examiner that Claims 73-106 are entitled to the priority date of provisional application 60/418,662 (10/15/2002). The limitation of "electronic circuitry carried on or in the substrate, wherein the electronic circuitry comprises information stored therein" is not supported in any previous parent application. Claims 107-110 are entitled to the priority date of US Patent 6,970,573 (11/9/2001). The limitation of "visible light scan data associated with text characters" is not supported in any previous parent application.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2135

Randal D. Moran
/RDM/

2/6/2008